

## Remarks

### Status of the Claims

Claims 1-25, 27, 28, 31-55, 57, 58, 61, 62, and 64 are pending in the application. Claims 57 has been allowed, claims 1-25, 27, 28, 31-54, 58, 61, 62, and 64 stand rejected, and claim 55 stands objected to as being dependent upon a rejected base claim. By this paper, claims 1, 27, 28, 61, and 64 have been amended. Reconsideration of all pending claims in view of the amendments and following remarks is respectfully requested.

### Rejections Under 35 U.S.C. 101

Claims 1-25, 27, 28, 61, and 64 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection. The phrase “automatically selecting” implies that the selection is performed by a machine (system 200) rather than a person. This reading is clearly supported by the specification:

Unlike conventional systems 100, the **system 200** of FIG. 2 **automatically selects**, from the available codecs 110, a particular codec 110 best suited to compressing each scene 206. ¶ 30 (emphasis added).

The specification criticizes conventional approaches in which selection is performed manually:

In certain cases, a content developer may be able to manually specify a change of codec 110 within a media signal 108 where, for instance, the content developer knows that one codec 110 may be superior to another codec 110. **However, this requires significant human effort and cannot be performed in real time.** ¶ 25 (emphasis added).

Furthermore, Applicants respectfully submit that a human being could not perform the step of “compressing the scenes.” Video compression is a process that requires many billions of calculations even for a short video clip. Human beings cannot perform video compression in their minds or on paper.

Nevertheless, to advance prosecution of the application, Applicants have amended claims 1, 27, 28, 61, and 64 to clarify that the recited steps are performed by a computer. In addition, Applicants have amended the rejected claims to recite that the automatic selection is performed “without human invention.”

Because the claims are now clearly tied to a particular machine or apparatus, Applicants respectfully submit that the claims recite statutory subject matter under *In re Bilski*.

#### Rejections Under 35 U.S.C. 112

Claim 61 was rejected under 35 U.S.C. 112, first paragraph, as being non-enabling. Applicant respectfully points out that the claims, which form part of the disclosure as originally filed, recited “a computer-readable medium, comprising: program code....” Furthermore, the original disclosure describes several “modules” within a source system 202 (e.g., “personal computer”) that perform the recited functions. See, e.g., ¶ 25 and Figs. 3-5 and 8-10. Personal computers inherently include memories and disk drives that store program code (“instructions”) that are executed on the computer. However, because the specification does not specifically refer to “computer-executable instructions,” Applicants have amended claim 61 to recite

"a computer-readable medium including program code," which is fully supported by the original specification and claims.

#### Double Patenting

Claims 1-24, 28, 31-54, 58, and 61-63 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,295,608. Enclosed herewith is a terminal disclaimer to obviate the double patenting rejection.

#### Conclusion

As the Office Action raises no further issues, Applicants respectfully submit that all claims are in condition for allowance. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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